

REMARKS

A. Status of the Claims

Claims 40-68 were pending at the time of the Restriction Requirement, with claims 1-39 having been canceled in the Preliminary Amendment filed with the application and claims 69-81 having been canceled, without prejudice or disclaimer, as being drawn to a non-elected invention in view of the election of the Group I invention made in response to the Restriction Requirement. Claim 55 has been amended to correct a minor typographical error. No new claims have been added, and no additional claims have been canceled. Therefore, claims 40-68 are pending and presently under consideration in the case.

B. Drawings

The Examiner requests that Applicants furnish a drawing under 37 CFR 1.81(c). Applicants note that the current application is a U.S. national stage application filed under 35 U.S.C. 371. The certified copy of the foreign priority application filed with the USPTO on April 29, 2005 includes four figures (pages 23-26 of the document). No translation is needed for the drawings included in the foreign priority application. Therefore, Applicants believe that the original drawings satisfy the requirement under 37 C.F.R. 1.81(c).

C. Claim Objections

The Examiner has noted that claim 55 reads "markings.." where it should read "markings." Applicants have amended the claim accordingly.

D. Claim Rejections based on 35 U.S.C. § 103

1. Claims 40-42

Claims 40-42 have been rejected under 35 U.S.C. § 103(a) as allegedly being obvious in view of U.S. Patent No. 6,103,518 to Leighton (“Leighton”). Assuming, without admitting, that Leighton discloses the features cited by the Examiner, the reference does not disclose or render obvious the subject matter of claims 40-42.

According to the Examiner:

Leighton does not specifically disclose superimposing a digital image on a surface, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a digital, microscopic image rather than just an image of a target site that can be view [*sic*, viewed] under a microscope so that one can observe the markings of target sites of interest in a zoomed in view where the image is easily observed in an expanded version.

Office Action, pp. 4-5.

Applicants respectfully traverse the rejection. As an initial matter, Applicants note the Examiner’s explanation in support of the obviousness conclusion does not satisfy the requirements laid out by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 167 L. Ed. 705 (2007). The explanation also does not satisfy the requirements of MPEP § 2141 (“Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103”), which provides:

When making an obviousness rejection, **Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.** In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

MPEP § 2141 (emphasis added).

In contrast to the requirements stated above, the explanation given in the Office Action does not include findings of fact concerning the state of the art and the teachings of the

references applied. The explanation merely provides a conclusory statement that it would have been obvious to one having ordinary skill in the art to “use” a digital, microscopic image rather than “just an image of a target site” that can be viewed under a microscope. A review of the language of claim 40 illustrates that the claim requires much more than just “using” a digital, microscopic image. For example, claim 40 requires “superimposing at least one digital, microscopic image of a section of at least one preparation on an image of a surface of the preparation” and “placing at least one marking on the superimposed image”.

As the Court stated in *KSR*, in order to facilitate review, an obviousness “analysis should be made explicit.” *KSR* 167 L. Ed. at 712. The analysis provided is completely devoid of any findings of fact regarding the state of superimposing digital, microscopic images of a section of a preparation on an image of a surface of the preparation. The only reference cited (Leighton) makes no mention of digital, microscopic images of a section, much less superimposing them on an image of a surface of the preparation. Leighton also does not mention placing a marking on the superimposed image to define a desired position at which a sample is to be punched out of the preparation. The Examiner also provides no other findings of fact regarding the state of the art regarding superimposing a digital, microscopic image of a surface of the preparation or placing a marking on the superimposed image. As a result, the explanation given in support of the obviousness conclusion does not satisfy the requirements under *KSR* or the MPEP.

Furthermore, assuming for sake of argument that the Examiner’s explanation did satisfy the factual inquiry requirements mentioned above, there are additional shortcomings in the analysis. Specifically, the explanation does not provide a reason that it would have been obvious for one skilled in the art to modify the method in Leighton to meet the limitations of claim 40. The reason provided in the Office Action for modifying Leighton is “so that one can observe the

markings of target sites of interest in a zoomed view where the image is easily observed in an expanded version.” Leighton clearly discloses that “a section of the donor block...can be mounted on a slide, inspected under a microscope, and target sites can be plotted and recorded[.]” Col. 7, lines 44-47. Inspecting a section of the donor block mounted on a slide under a microscope allows one to “observe the markings of target sites of interest in a zoomed view where the image is easily observed in an expanded version.” Consequently, the reasons stated by the Examiner would not have motivated one skilled in the art to modify the method disclosed in Leighton to superimpose a digital, microscopic image of a section of a preparation on an image of a surface of the preparation. Because the Leighton method already allowed a user to observe the target sites of interest in a zoomed view (*e.g.*, with the disclosed microscope and section mounted on a slide), there would be no motivation to perform such a modification.

For at least the foregoing reasons, Applicants respectfully submit that claim 40 is not obvious in view of Leighton. Accordingly, Applicants request the rejection be withdrawn and a timely notice of allowance be issued for claim 40. Claims 41-42 depend directly from claim 40, and are also allowable for at least the reasons provided above. Accordingly, Applicants request the rejection be withdrawn and a timely notice of allowance be issued for claim 41-42.

2. Claims 43-68

Claims 43-68 depend directly or indirectly from claim 40, and are also allowable for at least the reasons provided above. Accordingly, Applicants request the rejection be withdrawn and a timely notice of allowance be issued for claim 43-68.

E. Conclusion

Applicants believe this paper to be a full and complete response to the non-Final Office Action dated February 14, 2008. Applicants respectfully request favorable consideration of this case in view of the above comments and amendments.

Should the Examiner have any questions, comments, or suggestions relating to this case,
the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3072.

Respectfully submitted,



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Date: April 30, 2008